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10/538,312	10/14/2005	Gunnar Nitsche	066340.0223	4052
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EXAMINER				
CHENG, ICHIEH				
ART UNIT		PAPER NUMBER		
4183				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DL.NYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/538,312

Applicant(s)

NITSCHKE ET AL.

Examiner

ICHIEH CHENG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date 09/19/2005, 11/03/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17-19, 21-23 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 17, it is unclear what "the maximum data throughput" refers to. The claim does not specify the maximum data throughput of what. The examiner suggests modifying the phrase to "the maximum data throughput between the mobile station and the communication network."

Claim 18 and 19 recite the limitation "data storage" in claim 14. There is insufficient antecedent basis for this limitation in the claim. It is unclear what data storage refers to.

Claim 21 recites the limitation "the same access point" in claim 19. There is insufficient antecedent basis for this limitation in the claim. It is unclear what the same access point refers to. In addition, claim 21 does not distinctly claim how the mobile station logs off the current access point which is carrying out the identification process before the identification is carried out. Claim 21 recites: "the mobile station logs off the current access point which is carrying out the identification process," which seemingly requires that the logging off occur during the identification process. Claim 21 also

recites: "the mobile station logs off the current access point ... before the identification process is carried out," which seemingly requires the logging off to occur before the identification process. It is unclear whether the mobile station performs the log off before or during the identification process.

Claim 22 recites the limitation "the data storage" and "updating processes" in claim 14. There is insufficient antecedent basis for this limitation in the claim. It is unclear what the data storage and updating processes refer to. In addition, it is unclear what "other processes" refers to.

Claim 23 recites the limitation "updating connection option processes" in claim 14. There is insufficient antecedent basis for this limitation in the claim. It is unclear what updating connection option processes refer to.

As to claim 25, it is unclear "a data transmission pause" refers to.

Claim 26 recites the limitation "the stored data" and "another identification process" in claim 14. There is insufficient antecedent basis for this limitation in the claim. It is unclear what the stored data and another identification process refer to. In addition, the term "better transmission quality" is a relative term which renders the claim indefinite. The term "better transmission quality" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention because there are many ways to measure and define a better transmission quality.

Claim 27 recites the limitation "... switching to different standards and frequency bands ..." in claim 14. There is insufficient antecedent basis for this limitation in the

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claim. It is unclear what "switching" refers to. In addition, it is unclear what "a processor" refers to.

As to claim 28, it is unclear "other connection options" refers to. In addition, claim 28 does not particularly point out and distinctly claim "a periodic comparison between the connection parameters to the current access point and other connection options." (A parameter can not be compared to an access point because access points are machines and parameters are numbers.)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 14, 16-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lescuyer et al (EP 1257141), of record.

6. As to claim 14, Lescuyer et al. disclose automatically performing identification processes which identify usable connection options to different networks having different standards and frequency bands (Fig 4 and [0013]), wherein connection parameters which identify the standard with which a usable connection option is found are stored (Fig 4 and [0013]); selecting a usable connection option (Fig 4 and [0013]); and setting up a connection from the mobile station to the network via an access point after selection of connection parameters, wherein the connection is set up by the mobile station to the access point which is being communicated to via the standard for which the usable connection option has been selected (Fig 4 and [0013]).

Lescuyer et al. do not expressly disclose wherein a first standard is selected and a check is carried out of the usable connection options within this first standard, then a next standard is selected and a check is carried out of the usable connection options within this next standard.

However, Lescuyer discloses that the scan is conducted using information stored in the SIM card of the mobile station ([0013]). It would be cumbersome to have the mobile station switch parameters during the scan, so efficiency would dictate that the mobile would first scan using a set of parameters for a first standard and then scan using a set of parameters for a second standard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to scan by first selecting a standard and determining whether any connections complying with that standard are usable.

As to claim 16, Lescuyer et al. disclose wherein selecting a usable connection option comprises manual selection ([0013], where having a user decide to switch network is "manual selection")

As to claim 17, Lescuyer et al. disclose wherein selecting a usable connection option comprises selecting the connection option which achieves the maximum data throughput ([0013], where "the user decides to switch [networks] if the current download rate is too slow on the current system." This discloses selecting a connection which achieves the maximum data throughput.

As to claim 18, Lescuyer et al. disclose wherein an identification process and data storage are carried out before logging on a connection with an access point (Fig 4 and [0013]).

As to claim 19, Lescuyer et al. disclose wherein an identification process and data storage are carried out while a connection exists to an access point (Fig 4 and [0013]).

As to claim 20, Lescuyer et al. disclose before the identification process is carried out, a current access point is signaled that the mobile station cannot receive data for an agreed time, and arriving data is buffered in the current access point ([0043-0044]).

As to claim 22, Lescuyer et al. disclose the automatic identification and the data storage and updating processes are carried out within a time period in which no data is transmitted and during which the mobile station is not busy carrying out other processes that cannot be interrupted ([0013] and [0043-0044]).

As to claim 23, Lescuyer et al. disclose the identification and the data storage and updating connection option processes are carried out periodically ([0005]).

As to claim 24, Lescuyer et al. disclose the identification of usable connection options is carried out by transmission of a signal to possible access points and by evaluation of the received signal or just by evaluation of the received signal ([0013]).

As to claim 25, Lescuyer et al. disclose the identification of usable connection option is carried out in a data transmission pause during an active connection to an access point ([0013]).

As to claim 26, Lescuyer et al. disclose in the event of a deterioration in the transmission quality or a connection failure to the current access point, after accessing the stored data or another identification process, a connection change is made to an access point which ensures a better transmission quality (handover; [0002-0006])

7. Claim 15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lescuyer et al (EP 1257141) as applied to claim 14..

As to claim 15, Lescuyer et al. disclose selecting, but do not explicitly disclose selection under program control.

However, the examiner takes official notice that it is well known to provide a selection mechanism using program control because software is more flexible than hardware.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to include selecting a usable connection option under program control to improve the flexibility of a system.

As to claim 27, Lescuyer et al. disclose switching to different standards and frequency bands, but do not explicitly disclose this switching is carried out under program control or by rebooting a processor.

However, the examiner takes official notice that it is well known to provide a switching mechanism under program control to improve the robustness of a system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to include switching to different standards and frequency bands under program control or by rebooting a processor in order to improve the robustness of a system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ICHIEH CHENG whose telephone number is (571)270-1941. The examiner can normally be reached on Monday to Thursday 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 571-272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ichieh Cheng/
Examiner, Art Unit 4183

2/5/2008

IC

/Len Tran/
Supervisory Patent Examiner, Art Unit 4183